

*Remarks*

At the outset, Applicant respectfully acknowledges the Examiner's previous allowance of all claims at the end of 2002. Applicant further notes with confusion that after the counting of a notice of allowance as noted on the USPTO PAIR database, and after a March 27, 2003 telephone inquiry to Mr. Robert Reinhardt inquiring regarding the status of the present application, that a new nonfinal office action was mailed on April 23, 2003. After multiple phonecalls to Examiner Pwu, it was learned that the case has been reassigned first to Examiner Pwu to issue a new office action, and then later assigned back to Examiner Poinvil. Applicant's Representative notes for the record Applicant's dissatisfaction with the perceived unequal treatment with which the present application appears to have been prosecuted as compared to other patent applications in the USPTO. The case having been pulled after finding of allowable subject matter leaves the small entity Applicant questioning whether the USPTO will ever allow the application to issue.

Upon reconsideration of the application claims 1-17, 33, 34, 39, and 42-58 remain pending in the application, with claims 1, 3, 6, 11, 33, 34 and 49 being the independent claims. No claims are presently sought to be amended, as the claims as previously amended are believed to clearly distinguish the applied reference. The previous amendments are believed to have introduced no new matter. Applicant has not made the previous amendments to avoid the applied references. Applicant believes that all the pending claims are now in condition for

allowance. Applicant's previous arguments overcoming all previous rejections are incorporated herein by reference in their entirety to the extent that they apply.

Claims 1, 3, 6, 11, 33, 34, 39 and 49 were previously amended on several occasions in accordance with the personal interview with Examiner Poinvil of December 18, 2001 and subsequent telephonic interview on February 26, 2002. The present office action appears to assert that the changes required by the Examiner to place the application in condition for allowance, somehow are not supported by applicant's Specification or are indefinite. Applicant respectfully disagrees. Applicant has been unsuccessful at getting further clarification regarding the rejections, since the Examiner responsible for the case has changed three times over the course of the past year. Further, the Examiner in the present office action rejects all the claims under US Patent No. 5,970,469 to Scroggie ("Scroggie '469"), a reference which is a related patent to previously distinguished US Patent 6,014,634 to Scroggie ("Scroggie '634"). It is important to note that the previously distinguished patent actually included additional disclosure not found in the presently applied reference.

For at least the reasons provided in the previous five Amendments prepared by Applicant and filed **June 8, 2001, July 11, 2001, January 25, 2002, August 26, 2002, and December 18, 2002** the new claims are also patentable over the applied documents including the new references US Patent 6,278,980 to Wendkos and Scroggie '469.

Based on the above Amendment and the following Remarks, Applicant traverses the rejections and respectfully requests that the Examiner reconsider all outstanding rejections or objections and that they be withdrawn.

***Rejection Under 35 U.S.C. Section 112, 1<sup>st</sup> Paragraph***

The Examiner first rejects all claims as containing subject matter allegedly not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor at the time of filing possessed the invention.

MPEP § 2164 discusses the enablement requirement generally. The enablement requirement refers to the requirement of 35 U.S.C. § 112, first paragraph that the specification describe how to make and how to use the invention. The invention that one skilled in the art must be enabled to make and use is that defined *by the claims* of the particular application or patent.

It is well settled that patent applicants are not required to disclose every species encompassed by their claims, even in unpredictable arts. *In re Vaeck*, 947 F.2d 488, 496, 20 USPQ2d 1438 (Fed. Cir. 1991). However, there must be sufficient disclosure, either through illustrative examples or terminology, to teach those of ordinary skill how to make and use the invention as it is claimed. *In re Vaeck*. This means that the disclosure must adequately guide the art worker to determine, without undue experimentation, which species among all those encompassed by the claimed genus possess the disclosed utility. *Id.*

The test of enablement is whether one skilled in the art could make or use the claimed invention from the disclosures in the patent coupled with information known in the art without undue experimentation. *United States v. Telectronics, Inc.*, 857 F.2d 778, 8 USPQ2d 1217 (Fed. Cir. 1988); *In re Stephens*, 529 F.2d 1343, 188 USPQ 659 (CCPA 1976). A patent need not teach, and preferably omits, what is well known in the art. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 3 USPQ2d 1737 (Fed. Cir. 1987).

Enablement requires that the specification teach those in the art to make and use the invention without “undue experimentation.” *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). That some experimentation may be required is not fatal; the issue is whether the amount of experimentation required is undue. Determination of whether undue experimentation is needed is not based upon a single factor, but rather a conclusion reached by weighing many factors. Many of these factors were summarized in *In re Wands*, as follows:

- (1) The quantity of experimentation necessary (time and expense);
- (2) The amount of direction or guidance presented;
- (3) The presence or absence of working examples of the invention;
- (4) The nature of the invention;
- (5) The state of the prior art;
- (6) The relative skill of those in the art;
- (7) The predictability or unpredictability of the art; and
- (8) The breadth of the claims.

It is not necessary that every enablement analysis consider all of the factors. MPEP § 2164.01.

The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. *M.I.T. v. A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985). The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 190 USPQ 214 (CCPA 1976).

The burden of proving lack of enablement is on the Examiner. MPEP § 2164.04. In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 27 USPQ2d 1510 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.

Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. *In re Marzocchi*, 439 F.2d 220, 169 USPQ 367 (CCPA 1971). As stated by the court, "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in

a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." 169 USPQ at 370.

According to *In re Bowen*, 492 F.2d 859, 181 USPQ 48 (CCPA 1974) the minimal requirement is for the examiner to give reasons for the uncertainty of the enablement. This standard is applicable even when there is no evidence in the record of operability without undue experimentation beyond the disclosed embodiments.

Enablement must be commensurate in scope with the claims. MPEP § 2164.08. The determination of the propriety of a rejection based upon the scope of a claim relative to the scope of the enablement involves two stages of inquiry. The first is to determine how broad the claim is with respect to the disclosure. The entire claim must be considered. The second inquiry is to determine if one skilled in the art is enabled to make and use the entire scope of the claimed invention without undue experimentation.

Applicant also finds some inconsistency between the Examiner's insufficient disclosure argument and his alternative argument that the invention was obvious to one with ordinary skill in the art.

Detailed procedures for making and using the invention may not be necessary if the description of the invention itself is sufficient to permit those skilled in the art to make and use the invention. MPEP § 2164.

Applicant asserts that it would have been apparent to those skilled in the art that the language of the claims was supported. The language was required by the first Examiner in order to place the application in condition for allowance, see interview summary record. Then that same language is now being questioned by a second Examiner as unsupported. Applicant asserts that the claims as pending are fully supported by the written description and as described are enabled as not requiring undue experimentation. Thus, Applicant respectfully requests that the rejection be withdrawn.

***Rejection Under 35 U.S.C. Section 112, 2<sup>nd</sup> Paragraph***

The Examiner proceeds to reject the claims under 112 second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the invention. Applicant has amended the claims as required by previous office actions in five separate amendments, and requests reconsideration of the rejection. There is nothing indefinite about claiming an invention broadly. An Applicant is entitled to claim an invention as broadly as the prior art allows. Just because a claim is broad in scope, does not make it indefinite. Applicant asserts that from any fair reading of the claims, it should be clear to those skilled in the art how the consumer user is awarded, and how a consumer user is selected by a sponsor based on demographic and psychographic (behavior based demographic) criteria, as required by the first Examiner to place the claim in condition for allowance. Thus, Applicant respectfully requests that the rejection be withdrawn.

***Rejection Under 35 U.S.C. Section 102***

The Examiner proceeds to reject the claims as being allegedly unpatentable over US Patent 5,970,469 (“Scroggie ‘469”) at sections 9 and 10 of the office action. Applicant asserts that Applicant’s invention is patentable over Scroggie ‘469, for at least the reasons previously noted with reference to Scroggie ‘634, and as noted in the previous five amendments, the contents of which are incorporated herein by reference in their entirety.

Note that Scroggie ‘469, or ‘634, in FIG. 5 includes at reference numeral 158, a step of sending to a fulfillment house. Thus, Scroggie does NOT provide automated fulfillment as required in all pending claims of Applicant’s application.

The excerpt of Scroggie ‘469 relied upon by the Examiner, col. 10-col. 12 with relation to claim 39, relates to a process of “dynamic coupon creation” this has nothing to do with automated fulfillment. Further col. 6-7 with relation to claim 1, deals with a user logging into a system to provide advertised offers, and col. 13, where the reference teaches away by sending “untargeted messages” and sending email to consumers based on “non-demographic” criteria. Again, in no way can it be said that Scroggie ‘469 teaches each and every element of all the claims of the present application. Applicant further traverses the Examiner’s inherency arguments in relation to claims 3-5 and 44-45 and requests that the Examiner show support for the Examiner’s assertion of anticipation. The Examiner relies on similar arguments as above for rejecting claims 6-10 and 46-48, 11-17, 33, 34, and 49-58. For at least the reasons noted above



and discussed further below, Applicants assert that these claims are also patentable over the applied references.

Applicant's invention includes various differences over the applied references of record.

Claim 1, includes, inter alia,

a system for incentive program generation and *automated award fulfillment*, comprising:  
a host computer coupled to a network;  
a first database accessible from said host computer; and  
an *automated award fulfillment* application program executed on said host computer for participation in incentive programs of a plurality of providers in communication with an inventory management system associated with each of said plurality of providers wherein said automated award fulfillment application program provides *sponsor-selected fulfillment* comprising:  
providing a sponsor-selected specific award unit item, said *sponsor-selected specific award unit item* being *tailored to demographic and psychographic preferences* of a *sponsor-selected consumer user*, and providing a *sponsor-selected geographic location for fulfillment*.  
(Emphasis added).

Applicant asserts at the very least, claim 39 as amended to include claims 40 and 41 is allowable over the applied art as discussed with the first and now reassigned Examiner, during the previous personal interview. Applicant believes that all the claims of the Application, as previously amended, stand in a condition for allowance, and thus the Applicant requests that the application be passed to issue.

The "automatic fulfillment" of the present invention goes beyond the type of award fulfillment contemplated by Scroggie. There are fundamental differences between the present invention and Scroggie. First, the present invention allows far more flexibility for the *sponsor* of

the incentive program to design his award fulfillment program, via various *selections*, see claims as amended. Second, the present invention actually contradicts Scroggie in that the purpose of Scroggie is to provide convenience to the consumers, while the object of the present invention is to provide convenience to the *sponsor*. After the designation of the particular award, Scroggie merely delegates the actual delivery to a "fulfillment house," (see FIG. 5, ref. numeral 158) whereas the present invention allows the sponsor to coordinate the delivery of the award, or, alternatively, to designate to the consumer where the award may be retrieved. The addition of any of the previously applied references does not teach or suggest these fundamental differences.

Moreover, the combination of any of the previously applied references with Scroggie '469 would be improper since Scroggie '469 does not provide a motivation to combine itself with the previously applied references.

Scroggie deals with an e-coupon system with a fulfillment center.

Applicants also note that the present invention which deals with sponsor selected fulfillment is different from consumer shopping systems wherein a consumer provides a pickup location for a good purchased by the consumer.

Thus all previously pending claims 1-17, 33, 34, 39 and 42-58 are patentable over the applied references.

Applicant further respectfully points out that the Examiner has not proven his prima facie case of anticipation. The Examiner has not shown or suggested all the elements of Applicant's claimed inventions. To the extent that the Examiner might later argue that other references

could be combined with Scroggie '469 to allegedly render obvious the claimed invention, Applicants assert that it would be improper to combine the references absent a proper motivation. The Examiner cannot use hindsight to combine the references based on Applicant's Specification. The Examiner must teach a motivation to combine the references to properly prove his prima facie case of obviousness.

### *Conclusion*

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

EGGLESTON  
Appl. No. 09/412,147

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,

Date: 10/23/03

A handwritten signature in cursive script, appearing to read "Ralph P. Albrecht", written over a horizontal line.

Ralph P. Albrecht  
Attorney for Applicant  
Registration No. 43,466  
VENABLE  
P.O. Box 34385  
Washington, D.C. 20043-9998  
Telephone: (202) 344-4800  
Telefax: (202) 344-8300

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